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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,130	08/08/2003	Janel Lanphere	01194-465001 / 03-347	3843

26161 7590 12/16/2004

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EXAMINER

LE, HOA T

ART UNIT PAPER NUMBER

1773

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/637,130

**Applicant(s)**

LANPHERE ET AL.

**Examiner**

H. T. Le

**Art Unit**

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/03; 04.07.09/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. ClaimS 1-30, drawn to porous polymer particles, classified in class 428, subclass 402.
  - II. Claim 31, drawn to a method for making polymer particles, classified in class 521, subclass 62.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another materially different product such as polymerizing two monomers in an emulsion containing a polymer initiator.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Sean Daley, Attorney for Applicants, on December 8, 2004, a provisional election was made with traverse to prosecute the invention of group I, claims 1-30. Affirmation of this election must be made by applicant in replying

to this Office action. Claim 31 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Double Patenting*

6. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 19-33 of copending Application No. 10/215,594. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two sets of claims substantially are directed to nearly identical product, i.e. porous polymer particles, except for the particle diameter of the product. The particle diameter of the particles recited in the instant claims is within that of the reference claims; therefore, the reference claims read on the instant claims. With regard to the pore density, the reference claims recite fewer large pores in the surface than in the interior region which indicates that the pore in the interior region is different from that in the surface area. In addition, fewer large pores in the surface as recited in the reference claims would necessarily results in higher density in the interior region as region.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3, 5-8, 11, 13, 14, 18-20, 22, and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Porrvik (US 5,902,834).

Claim 1: Porrvik discloses porous polymer particles having particle diameter of up to 2000 microns (see col. 2 lines 30-35). The particles can be varied within this range depending on the application. However, Porrvik gave a specific example of selecting particles up to 500 microns (col. 5, lines 33-34). See also table I. With regard to the pore density, because the particles are not disclosed to be perfectly uniformly porous, it necessarily follows that different regions exhibit different pore density, namely the pore density of the interior region is different from that of the outermost region.

Claim 3: Same reasoning is applied to the average pore density.

Claims 5-8: See col. 2, lines 42-56 and table I.

Claim 11: surface of the particles modified with dextran is taught at col. , lines 53+. Dextran is a bioabsorbable material.

Claims 13 and 14: The particles are spherical (col. 1, lines 55-56); therefore, their sphericity must be at least 0.9 or more.

Claims 18 and 19: See claims 5, 6 and 13. These polymers are insoluble in DMSO and are free of animal-derived compounds.

Claim 20: See rejections to claim 1 and 3.

Claims 22 and 30: See claim 7 and rejection to claim 1 regarding the plurality of particles and particle diameter. See col. 1, lines 8-16 where a fluid carrier is suggested.

Claims 25-29: See col. 2, lines 42-56 and table I.

9. Claims 1, 3, 5-8, 9, 18-20, 22, and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Blankenship (US 6,632,531).

Claim 1: Blankenship discloses a porous polymer particle having a particle diameter of 250 microns or less (col. 3, lines 7-10) which is right in the claimed range. The polymer particle is porous, so it's expected to have a pore density. Because the particle is not disclosed to be perfectly uniformly porous, it necessarily follows that different regions exhibit different pore density, namely the pore density of the interior region is different from that of the outermost region.

Claim 3: The pore densities are different for different regions, so do the average pore densities.

Claims 5-8: See col. 3, lines 7-10.

Claims 9, 18 and 19: See col. 16, lines 32-65. Those polymers are insoluble in DMSO and are free of animal-derived compounds.

Claim 20: See rejection to claim 1.

Claims 22 and 30: See col. 26, lines 13-18. The plurality of particles are in an aqueous emulsion, thus it is dispersed in a carrier fluid.

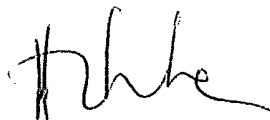
Claims 25-29: See col. 3, lines 7-10.

10. References not relied upon are cited as art of interest.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le  
Primary Examiner  
Art Unit 1773